

REMARKS

The Examiner has rejected claims 40-48, 50 and 73-74 as being unpatentable under 35 U.S.C. § 103(a) over Summers (U.S. Patent No. 6,080,191) in view of McCrory (U.S. Patent No. 5,951,599) in further view of Myers et al. (U.S. Patent No. 5,700,285). The Applicant requests clarification of the status of claim 49 since the office action summary indicates that claim 49 stands rejected but the Examiner's comments make no reference to claim 49. The Applicant has carefully considered the Examiner's comments. However, Applicant respectfully disagrees with the Examiner's conclusion that the claimed invention would have been obvious from the prior art relied upon by the Examiner.

35 U.S.C. § 103 requires that the subject matter of the claimed invention be considered "as a whole." The ultimate question under 35 U.S.C. § 103 is "whether the claimed invention as a whole would have been obvious," "not whether the differences [between the claimed invention and the prior art] themselves would have been obvious." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983); see also *Schenk v. Norton Corp.*, 713 F.2d 782, 785 (Fed. Cir. 1983).

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

"That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698 (Fed. Cir. 1983).

"The 'as a whole' instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference

containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result—often the very definition of invention.” *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004).

“This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result—often the essence of invention.”

Princeton Biochemicals, Inc. v. Beckman Coulter, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Contrary to the admonitions of the Federal Circuit, the Applicant contends that the Examiner has engaged in impermissible hindsight to construct Applicant’s invention piece-by-piece from the prior art using Applicant’s claims as a roadmap. Like the example given in *Ruiz v. A.B. Chance*, the Examiner has broken Applicant’s claims into component parts A, B and C to declare that the claims are obvious. In the Examiner’s analysis, component A is the structure of the stent, which the Examiner argues is found in the Summers reference. Component B in the Examiner’s analysis is the graft layer, which the Examiner argues is found in the McCrory reference. Component C in the Examiner’s analysis is the means of attaching the graft layer to the stent, which the Examiner argues is found in the Myers et al. reference. Using hindsight and the Applicant’s claims as a roadmap, the Examiner has combined components A, B and C of Summers, McCrory and Myers et al. to reconstruct Applicant’s claims.

However, the motivation to combine Summers, McCrory and Myers et al. in the manner that the Examiner has attempted is lacking. The Examiner argues that Summers discloses attaching a graft material to the stent structure. However, the Examiner admits that Summers does not disclose a graft material extending only a partial distance along the circumference. In fact, the Examiner relies upon two summary paragraphs at the end of Summer that broadly describe alternative embodiments. (Col. 11, lines 25-52). None of the drawings in Summers actually shows a graft attached to the stent. Moreover, there is no description of how a graft layer

extending only a partial distance along the circumference would be attached to the stent structure of Summers.

The Examiner argues that McCrory satisfies part of the omission in Summers because McCrory discloses a stent frame with a permeable portion and a less permeable portion. (Col. 3, lines 1-22). However, in the only embodiment in McCrory where the occlusion device is used to treat an aneurysm that is adjacent perforating vessels, McCrory teaches away from the use of a stent with a graft extending only a partial distance along the circumference. This is one of the advantages of Applicant's claimed stent as shown in Figure 10 of Applicant's specification. By contrast, McCrory states that when perforating vessels are adjacent the aneurysm, it is difficult to orient the partial graft layer relative to the aneurysm. (Col. 4, line 58 to col. 5, line 10). In this situation, McCrory recommends making the stent structure over the aneurysm less permeable after the occlusion device is deployed. Moreover, as shown in Figure 3D of McCrory, the less permeable portion extends around the entire circumference of the stent when adjacent perforating vessels exist.

The Examiner admits that Summers and McCrory do not disclose Applicant's means for attaching the partial graft to the stent structure. The Examiner relies upon Myers et al. for this missing piece of the puzzle. However, Myers does not even refer to a graft layer that extends only a partial distance along the circumference of the stent. In all of the embodiments disclosed in Myers et al., the graft layer extends around the entire circumference of the stent. Myers makes no suggestion that the graft layer could extend only partially along the circumference.

A proper suggestion or motivation to combine multiple references is needed to make out a case of obviousness. The Examiner's rejection does not provide a basis for combining Summers, McCrory and Myers et al. in the manner that the Examiner proposes. Therefore, the Examiner's obviousness rejection should be withdrawn. Accordingly, Applicant requests reconsideration and allowance of the application.

Prior to the next office action, Applicant's attorney requests an interview with the Examiner. On May 18, Applicant's attorney spoke to the Examiner's supervisor, Anhtuan T. Nguyen, to request an interview since the Examiner was not available. Mr. Nguyen explained that because of scheduling issues it would not be possible to conduct

an interview prior to the deadline for filing a reply. Instead, Mr. Nguyen recommended requesting an interview in this reply with the Examiner and the SPE prior to the next office action. Accordingly, Applicant's attorney (Richard E. Stanley, Jr.) may be reached at 312-321-4279.

Respectfully submitted,



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